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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,753	11/21/2003	Ulrich Bohne	2818	9134

7590 08/01/2005

STRIKER, STRIKER & STENBY
103 East Neck Road
Huntington, NY 11743

EXAMINER

RACHUBA, MAURINA T

ART UNIT	PAPER NUMBER
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3723

DATE MAILED: 08/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Supplemental
Office Action Summary

Application No.

10719,753

Applicant(s)

BOHNE ET AL.

Examiner

M Rachuba

Art Unit

3723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-7,10,13 and 14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-7,10,13 and 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings are finally objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the structure which allows the auxiliary handle to be turnable between a plurality of turning positions and arrestable in at least one of the turning positions; the structure allows the outlet pipe to be "formed turnable" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1, 3-7, 10 and 13 ~~are~~ finally rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Regarding claim 1, applicant now claims that the auxiliary handle is "transverse" to the first handle. The specification only describes the auxiliary handle being parallel to the rotational axis of the tool. This does not require that the auxiliary handle be transverse to the first handle, as there is no specific disclosure to the positioning of the first handle other than the example shown in the figures. Further, the specification states that the auxiliary handle is turnable between a plurality of turning positions and arrestable in at least one of the turning positions; the structure that allows the outlet pipe to be "formed turnable" is not described in such a way as to enable one skilled in the art to make the device as claimed. Applicant's description only states that the pipe is turnable, without providing an example of the structure required to allow the pipe to turn or without stating that such structure is conventional.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1, 3-7, 10, 13 and 14 are finally rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Please refer to the rejection above. Claim 5, what is meant by "formed turnable"? Is it the pipe that is turnable? (i.e. flexible?). Or is there a connection between the pipe and second handle that allows the pipe to turn relative to the second handle? The scope of this claim cannot be readily determined. Further, claims 1 and 14 as amended limit the hood to carrying "cooling air which has left said housing *before after which* having passed...". It is not clear what structure is being claimed.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 3, 4, 6, 7, 10, 13 and 14 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by DE 644011 (with English translation) (cited by applicant). Please refer to figures 1 and 2, and their descriptions.

Response to Arguments

8. Applicant's arguments filed 02 May 2005 have been fully considered but they are not persuasive. Regarding the argument traversing the rejection of claim 5 under 35 USC 112, the examiner does not agree. Applicant has only discloses that the pipe is turnable, there is no disclosure as to the structure that allows the function of turning, nor

any examples or statements that the structure is conventional. Further, applicant argues that '011 does not disclose the invention now claimed. The examiner disagrees. '011 discloses an electric hand power tool, comprising a housing 2; an air-cooled electric motor 1 which is accommodated in said housing, a tool 11 which is driven by the electric motor, a protective hood (see figure 1) which at least partially covers the tool; the housing having a handle 18 and an auxiliary handle 16 for a two-hand guidance of the hand power tool, said auxiliary handle (at least at the outlet pipe end 13) being positioned in a plane transverse to a plane of handle 18 and with reference to a work direction before the first-mentioned handle, the auxiliary handle being completely hollow and carrying motor cooling air which has left the housing after having passed said protective hood, so that said auxiliary handle being operative for damping a flow noise of the air. Applicant has presented no evidence that the air flow through the auxiliary handle of '011 would not dampen the noise of the air flow. As '011 clearly discloses the same invention, it would be inherent that '011 dampens the noise of the air flow. Regarding applicant's arguments filed 13 July 2005, the examiner does not agree. DE '001 clearly shows two air streams, one from the motor, and one from the hood, that meet at 14. The outlet 15 is of a large diameter, but is not especially horn shaped. Without further evidence to the contrary, it is the examiner's position that DE '011 clearly anticipates the claimed invention.

Conclusion

9. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M Rachuba whose telephone number is **571-272-4493**. The examiner can normally be reached on Monday-Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hail can be reached on **571-272-4485**. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M Rachuba


M. Rachuba
Primary Examiner